

Appl. No. 09/638,570
Docket No. 7721M
Amdt. Dated March 5, 2007
Reply to Office Action mailed on February 5, 2007
Customer No. 27752

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REMARKS

Applicants thank the Examiner for the consideration given the present application. Claims 55-79 are pending and Claims 55 and 61-64 are presently amended. Claims 1-54 were cancelled previously. No new claims have been added.

Rejection Under 35 USC §112, First Paragraph

The Office Action states that the claims(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 55 has been amended to include the limitation "said coffee grounds are extracted which end brewing the coffee extract".

Claims 56 - 79 all depend from claim 55 either directly or indirectly and are thus believed to correct the matters which served as the basis for the objection and respectfully request reconsideration and that the objection be withdrawn.

Rejection Under 35 USC §112, Second Paragraph

Claims 55 - 79 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 55 has been amended to include the limitation "said coffee grounds are extracted which end brewing the coffee extract".

Claims 56 - 79 all depend from claim 55 either directly or indirectly and are thus believed to correct the matters which served as the basis for the objection and respectfully request reconsideration and that the objection be withdrawn.

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Rejection Under 35 USC §102 Over Pitchon

The Examiner has maintained the rejection of Claims 55, 61, 63, 64, 65, 75, 76, and 79 under 35 U.S.C. § 102 as allegedly being anticipated by Pitchon et al., U.S. Patent No. 3,790,689 (hereafter "Pitchon"). Applicants respectfully traverse this rejection.

Under 35 U.S.C. § 102, a claim is anticipated only if each and every claim element is found, either expressly or inherently disclosed, in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. See *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Additionally, there must be no difference between what is claimed and what is disclosed in the applied reference. See *Scripps v. Genetech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Moreover, it is incumbent on the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990).

Applicants respectfully assert that Pitchon does not anticipate the present invention as under §102 as required by amended claim 55 because Pitchon does not teach the portion of coffee extract is diluted after filtering but before dispensing, as required by the amended claims herein. Therefore, because Pitchon fails to teach, the portion of coffee extract is diluted after filtering but before dispensing. Claims 61, 63, 64, 65, 75, 76, and 79 all depend from claim 55 either directly or indirectly and are thus believed to be patentable over Pitchon for the same reasons as claim 1.

Applicants respectfully assert that Pitchon does not anticipate the present invention under §102.

Rejection Under 35 USC §103(a) Over Levinson in view of Coleman, GB 2111377, or
Sullivan

The Examiner has rejected Claims 56 and 58 under 35 U.S.C. § 103 as being unpatentable over several references. In general, the Examiner relies on Levinson alone and taken together with Coleman, U.S. Patent No. 2,047,172 (herein "Coleman"), GB

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21113777 (herein "GB"), and Sullivan, U.S. Patent No. 2,950,375 (herein "Sullivan") to obviate the present claims.

More specifically, the Examiner relies on Levinson to generally teach a process for preparing a brewed coffee beverage as previously described. The Examiner admits that "Levinson is silent regarding diluting the coffee extract after filtering but before dispensing." However, Anson is relied on to teach diluting beverages as a way to adjust temperature and thus, the Examiner concludes that it would have been obvious to dilute the coffee of Levinson to control the temperature of the beverage. Applicants respectfully traverse these rejections.

Applicants respectfully submit that, a reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore and Assoc., Inc.

In addition, the Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983). Distilling the invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Inventors of unobvious compositions, such as those of the present invention, enjoy a *presumption* of non-obviousness, which must then be overcome by the Examiner establishing a case of prima facie obviousness by the appropriate standard. If the Examiner does not prove a prima facie case of unpatentability, then without more, the Applicant is entitled to grant of the patent. See In re Oetiker, 977 F.2d 1443.

To establish a prima facie case of obviousness under 35 U.S.C. §103, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the cited reference must teach or suggest *all* the claim limitations. See, for example, In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Applicants

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respectfully assert that the Office Action fails to establish the second and third criteria, and thus, fails to make a prima facie case of obviousness under 35 U.S.C. § 103.

First, there is no likelihood success. For the reasons discussed previously in regards to the teachings of Levinson, Applicants respectfully assert that Levinson provides no likelihood of success. Moreover, the additional cited references do nothing to remedy the deficiencies of Levinson. In particular, none of the cited references teaches diluting the coffee extract after filtering but before dispensing. It is respectfully asserted that Levinson, both alone and when taken together with the additional references, fails to provide a likelihood of success and thus, for this reason alone, fails to establish a prima facie case of obviousness.

Additionally, there is no teaching of all the claim limitations. Again, none of the references, either alone or in combination, teach diluting the coffee extract after filtering but before dispensing, as claimed in the presently amended Claim 55, from which all other claims herein ultimately depend. Because the references fail to teach all of the present claim limitations, Applicants respectfully assert that for this additional reason, a prima facie case of obviousness has not been established. Claims 55, 61 - 64, 67 - 70, and 73 - 79 all depend from claim 55 either directly or indirectly and are thus believed to be patentable over Pitchon for the same reasons as claim 55.

For these additional reasons, it is respectfully asserted that the present claims are not obvious in view of the cited references, and it is therefore respectfully requested that the rejection under 35 U.S.C. §103 be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner's objections under 35 U.S.C. §112 and the Examiner's rejections under 35 U.S.C. §§ 102 and 103 have all been overcome. Withdrawal of these rejections is respectfully requested.

Respectfully submitted,

By 
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